



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,776	10/30/2000	Mitchell Joseph Alosa Morris	MJAM-1999-002	7022

7590 04/04/2002

Mitchell Joseph Alosa Morris  
100 Old Lyme Road  
Purchase, NY 10577

EXAMINER

RUDE, TIMOTHY L

ART UNIT	PAPER NUMBER
----------	--------------

2871

DATE MAILED: 04/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/699,776

Applicant(s)

MORRIS, MITCHELL JOSEPH  
ALOSA

Examiner

Timothy L Rude

Art Unit

2871

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 30 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-17 and 20 is/are rejected.
- 7) ☒ Claim(s) 18 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Objections***

1. Claim 8 is objected to because of the following informalities: The recitation "of said plurality or regions" should read -- of said plurality of regions --. For examination purposes, the recitation shall be considered as -- of said plurality of regions --.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

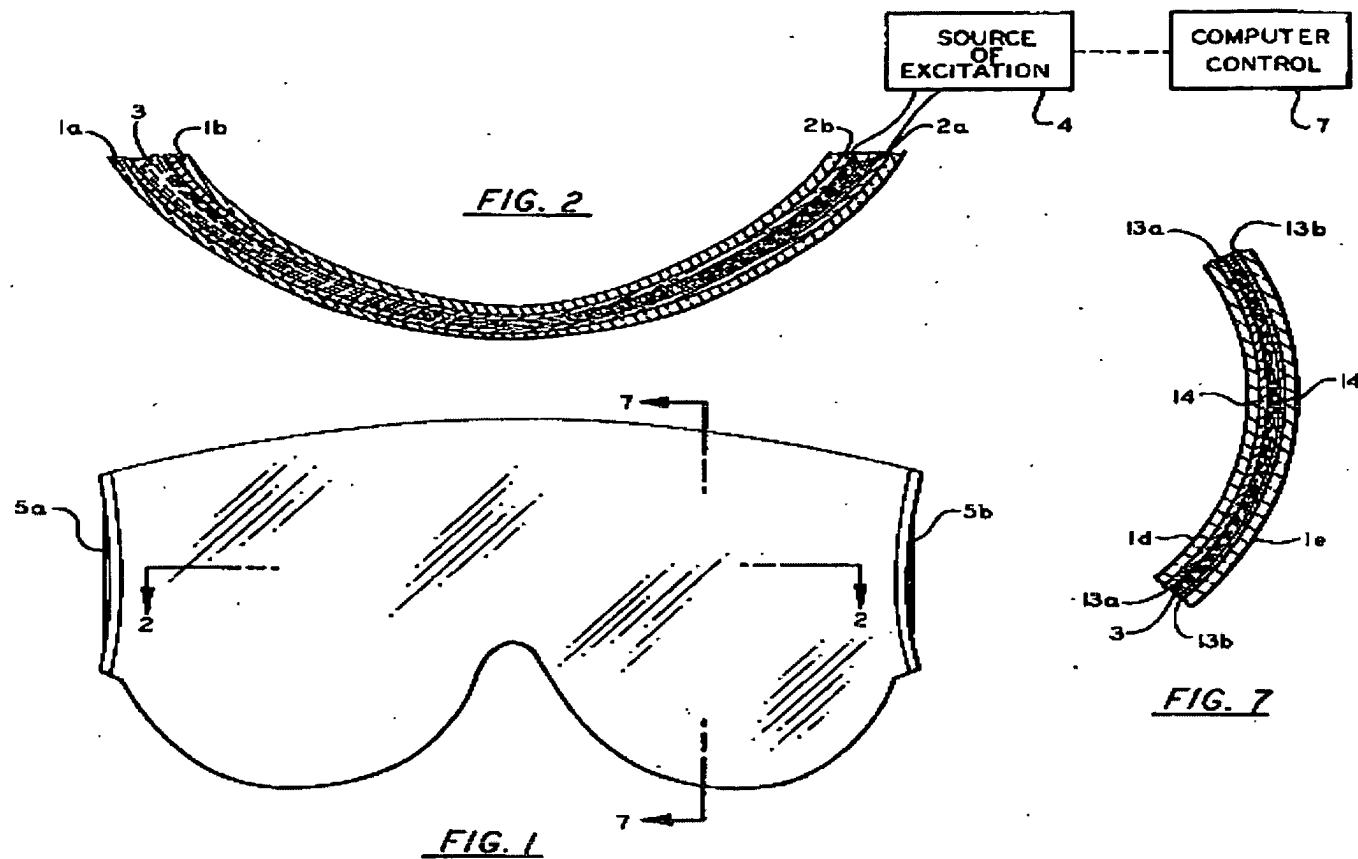
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 8, 9, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoyt et al (Hoyt) USPAT 3,942,270.

As to claim 1, Hoyt discloses in Figures 1-7 an eye shade apparatus having a variable transmission comprising: an electro-optic lens, Figure 1; a variable power source, 4 in Figures 2, 4, and 5, for controlling the transmission of said electro-optic lens to have a nonuniform, 2c through 2i in Figure 5, light transmission (col. 4, lines 31-58).



As to claim 2, Hoyt discloses in Figures 1-7 an eye shade apparatus according to claim 1 wherein said electro-optic lens comprises a liquid crystal material, 3 in Figure 2, (col. 3, lines 64-66).

As to claim 3, Hoyt discloses in Figures 1-7 an eye shade apparatus according to claim 1 wherein said electro-optic lens comprises p-methox-ybenylidene-p-n-butylaniline (Applicant's electro-optically active crystals) (col. 3, lines 64-66).

As to claim 8, Hoyt discloses in Figures 1-7 an eye shade apparatus according to claim 1 wherein said electro-optic lens comprises a plurality of regions, 2c through 2i, said variable power source comprises a plurality of power outputs (lines from selection matrix, 11) each of said plurality of power outputs corresponds to at least one of said plurality or regions (per Figure 5).

As to claim 9, Hoyt discloses in Figures 1-7 an eye shade apparatus according to claim 8 wherein the power applied to each of said plurality of regions can be the same (Abstract, simulate total black-out) or different (Abstract, simulate loss of peripheral vision).

As to claim 13, Hoyt discloses in Figures 1-7 an eye shade apparatus according to claim 8, further comprising a computer or a mechanically programmed selection matrix provided as a means of controlling the magnitude and application sites of excitation (Applicant's electronic storage medium storing a plurality of power patterns for applying to said plurality of power outputs and a switch for selecting said plurality of power patterns) for controlling the variable optical media (VOM).

As to claim 14, Hoyt discloses in Figures 1-7 an eye shade apparatus according to claim 1, wherein said electro-optic lens has variable color (col. 2, lines 58-65).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

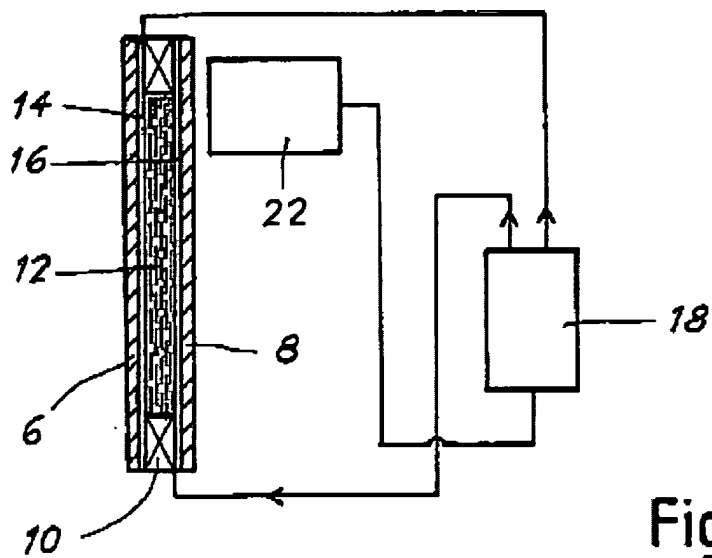
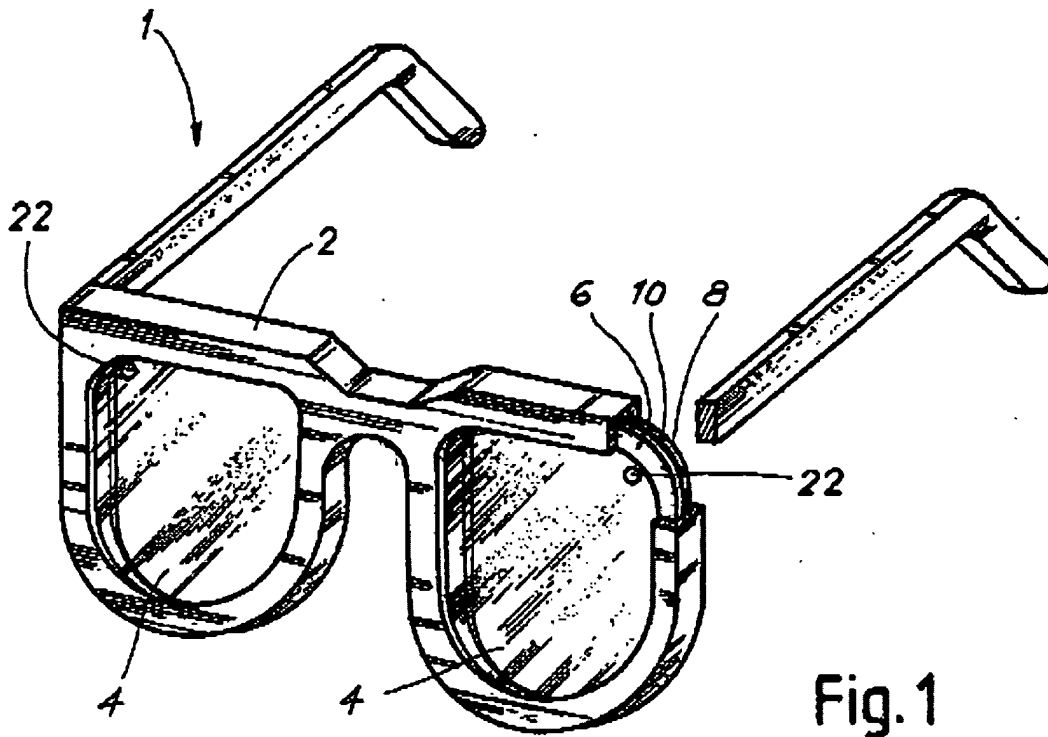
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4-7, 10-12, 16, 17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyt, as applied to claims 1 and 8, in view of Grupp USPAT 5,608,567.

As to claims 4 and 10, Hoyt discloses the eye shade apparatus according to claim 1 and according to claim 8.

Hoyt does not explicitly disclose a variable power source comprising a manual control to vary said power source.

Grupp teaches in Figures 1 and 2 a liquid crystal (col. 3, lines 23-26) eye shade apparatus with a voltage generating means, 18, with manual control (Abstract) to vary the transmission of the cell, 4, to protect the eyes.



Grupp is evidence that ordinary workers in the art of liquid crystals would find the reason, suggestion, or motivation to add manual control to vary light transmission protect the eyes.

Therefore, it would have been obvious to one having ordinary skill in the art of liquid crystals at the time the invention was made to modify the eye shade of Hoyt with the manual control of Grupp.

As to claims 5, 11, 16, 17, and 20, Hoyt discloses the eye shade device according to claim 1.

Hoyt does not explicitly disclose a variable power source comprising a photosensitive control to vary said power source in response to the intensity of light incident on said eye shade device.

Grupp teaches in Figures 1 and 2 a liquid crystal (col. 3, lines 23-26) eye shade apparatus with a voltage generating means, 18, with one or several photosensitive sensors, 22, (col. 3, lines 39-53) to automatically control the transmission of the cell, 4, to protect the eyes (Abstract).

Grupp is evidence that ordinary workers in the art of liquid crystals would find the reason, suggestion, or motivation to add photosensitive control to automatically vary light transmission to protect the eyes.

Therefore, it would have been obvious to one having ordinary skill in the art of liquid crystals at the time the invention was made to modify the eye shade of Hoyt with the photosensitive control of Grupp.



As to claims 6 and 12, Hoyt discloses the eye shade apparatus according to claim 1.

Hoyt does not explicitly disclose a manual mode of operation wherein said variable voltage source comprises a manual control to vary said power source and an automatic mode of operation wherein said power source comprises a photosensitive control to vary said power source in response to the intensity of light incident on said eye shade device and a switch permitting selection of said manual mode of operation or said automatic mode of operation.

Grupp teaches as prior art the use of a cut-out switch (col. 1, lines 55-61) to manually versus automatically control the shade. Furthermore, Grupp teaches the use of automatic and manual control (Abstract) which would most commonly entail the use of a switch to select manual versus automatic mode (as well as power off). Also, the use of a switch to select operating modes and to turn the device off is considered an obvious expedient to control the device.

Grupp is evidence that ordinary workers in the art of liquid crystals would find the reason, suggestion, or motivation to add a switch to select manual versus automatic mode. Motivational advantages include easy mode selection, battery conservation (power off), and manual override.

Therefore, it would have been obvious to one having ordinary skill in the art of liquid crystals at the time the invention was made to modify the eye shade of Hoyt with the switch of Grupp.

As to claim 7, Hoyt discloses the eye shade apparatus according to claim 1.

Hoyt does not explicitly disclose an electro-optic lens comprising one region, the transmission of which is controlled by said variable power source.

Grupp teaches in Figures 1 and 2 a liquid crystal (col. 3, lines 23-26) eye shade apparatus with a voltage generating means, 18, with a photosensitive control, 22, (col. 3, lines 39-53) to automatically vary the transmission of the cell, 4, comprising one region (col. 3, lines 11-38) to protect the eyes (Abstract).

Grupp is evidence that ordinary workers in the art of liquid crystals would find the reason, suggestion, or motivation to add an electro-optic lens comprising one region to protect the eyes.

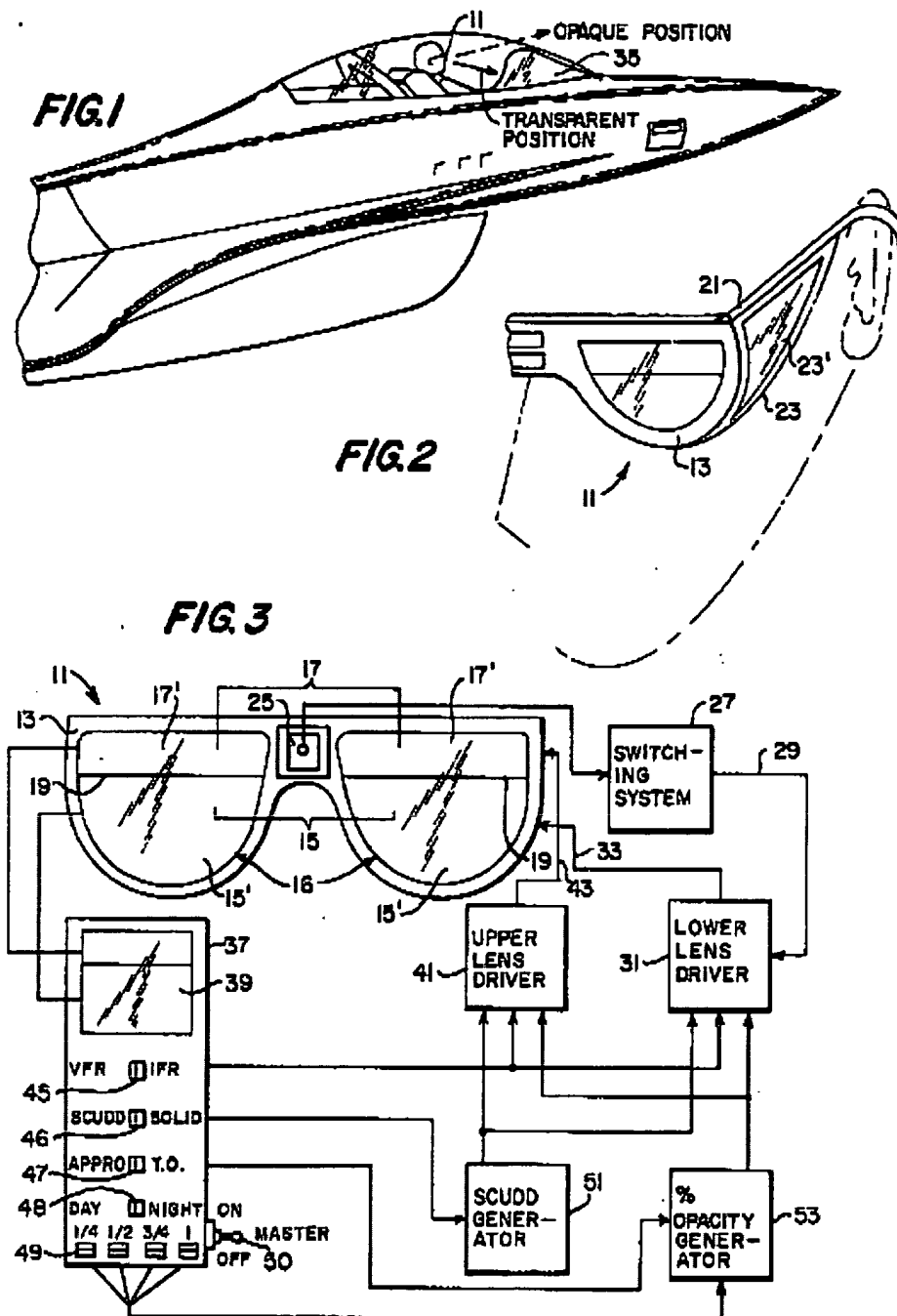
Therefore, it would have been obvious to one having ordinary skill in the art of liquid crystals at the time the invention was made to modify the eye shade of Hoyt with the one region lenses of Grupp.

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyt in view of Grupp as applied to claims 1 and 17 and further in view of Witt USPAT 4,106,217.

As to claim 15, Hoyt discloses an eye shade apparatus according to claim 1.

Hoyt does not explicitly disclose an eye shade apparatus comprising a first and a second lens adapted for shading a first and second eye of (Applicant's or) a user and a first and second side lens.

Witt teaches in Figures 2 and 3, an eye shade apparatus comprising a first and a second lens, 17, adapted for shading a first and second eye of a user and a first and second side lens, 23, to simulate flight through particular weather and cloud conditions (Abstract).



Witt is evidence that ordinary workers in the art of liquid crystals would find the reason, suggestion, or motivation to add an eye shade apparatus comprising a first and

a second lens adapted for shading a first and second eye of a user and a first and second side lens to simulate flight through particular weather and cloud conditions.

Therefore, it would have been obvious to one having ordinary skill in the art of liquid crystals at the time the invention was made to modify the eye shade of Hoyt with the first and a second lens adapted for shading a first and second eye of a user and a first and second side lens of Grupp.

***Allowable Subject Matter***

5. Claims 18 and 19 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

As to claim 18, a search of relevant prior art did not disclose, alone or in combination, the eye shade apparatus according to 1 wherein said apparatus comprises four electro-optic lenses which comprises two side lenses and two forward lenses, *and four photosensitive regions, one for each of said four electro-optic lenses.*

As to claim 19, a search of relevant prior art did not disclose, alone or in combination, the eye shade apparatus according to claim 17 further including a

*processor to determine said nonuniform light transmission from responses of said photosensitive regions.*

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy L Rude whose telephone number is (703) 305-0418. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William L Sikes can be reached on (703) 308-4842. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7724 for regular communications and (703) 308-7725 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.



Timothy L Rude  
Examiner  
Art Unit 2871

TLR  
March 25, 2002



TOANTON  
PRIMARY EXAMINER